

REMARKS/ARGUMENTS

Claims 1 and 3-26 were presented for examination and are pending in this application. In an Official Office Action dated November 27, 2006, claims 1 and 3-26 were rejected. The Applicant thanks the Examiner for his consideration and addresses the Examiner's comments concerning the claims pending in this application below.

Applicant herein amends claims 1, 3-8, 16-22 and 24-26 and respectfully traverses the Examiner's prior rejections. No claims are presently canceled and no new claims are presently added. These changes are believed not to introduce new matter, and their entry is respectfully requested. The claims have been amended to expedite the prosecution and issuance of the application. In making this amendment, the Applicant has not and is not narrowing the scope of the protection to which the Applicant considers the claimed invention to be entitled and does not concede, directly or by implication, that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, the Applicant reserves the right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and withdraw them.

Rejection of Claims

Claim 1 is provisionally rejected under the judicially created doctrine of obvious-type double patenting over co-pending Application No. 09/10,642. Upon the determination of allowable subject matter a timely terminal disclosure will be filed. The Applicant requests the rejection be held in abeyance.

Claims 1, 3, 7-9, 11-14 16 and 18-25 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,486,826 by Wolff et al ("Wolff"). Claims 1, 16, 24, 25, and 26 were rejected as being anticipated by U.S. Patent No. 6,032,271 by Goodrum et al. ("Goodrum"). Claims 4-6, 10, 15, 17 and 26 are rejected under 35 U.S.C. § 103(a) as being obvious over Wolff in view of various pieces of art. The Applicant traverses these rejections in light of the aforementioned amendments and the following remarks.

The Office Action of November 27, 2006 argues that Wolff discloses a "bus protocol for transmitting data on the bus" in column 19 lines 45-49 of Wolff. The cited section of Wolff appears to describe a bus protocol that controls logic in each unit of a computing module so that each unit provides a specific operation in response to a bus error signal. It does not appear that this protocol defines the composition of the packet. For example, it does not appear that neither Wolff nor Goodrum disclosures, suggest or teach that the bus protocol of Wolff or PCI protocol of Goodrum defines the size of a requested transaction or the type of the transaction. The protocol-defined packets of the Applicant's invention include an opcode field. This field defines the packet as a response or request packet which includes a transaction type identifier. When the packet is a request packet the opcode field further defines both the size of the transaction.

The Applicant also contends that the placement of the packets on the interface for analysis such as the debugging of the circuit by a debugging module is neither disclosed by Wolff nor Goodrum. While Wolff arguably teaches a debugging module it fails to disclose debugging a circuit by placing the protocol-defined information packet on the interconnect for analysis as is presently claimed. Nor does Wolff or Goodrum disclose the capturing of portion of a packet that meet a condition and responsive to that determination, prevent

further packets from entering the interconnect from the source of the original packet.

The Applicant thus deems independent claims 1, 16, and 24-26 not anticipated by either Goodrum or Wolff. As the rejection of claims dependent on claims 1, 16, and 24-26 under 35 U.S.C § 103(a) are based on either Goodrum or Wolff, and the additional art fails to resolve the argued deficiencies of Wolff and Goodrum, they too are deemed patentable. Reconsideration is respectfully requested.

While the Applicant believes the aforementioned amendments and discussion traverse the pending rejections, the Applicant asserts that Examiner improperly uses the Applicant's invention as a blueprint by which to craft unsupported rejections under 35 U.S.C. §103(a). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir., 1990). According to the Federal Circuit, this motivation may be found implicitly or explicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved leading inventors to look to reference relating to possible solutions to that problem. See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. (Mo.), 2000). To prevent the use of hindsight based on the Applicant's invention to defeat the patentability of the Applicant's invention, the Examiner must show a motivation to combine the references that create the case of obviousness. "In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited

prior art references for combination in the manner claimed.” *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir., 1998). The question is not whether given the Applicant’s invention, could one skilled in the art craft the claimed invention using the cited teachings. Rather the question is would one faced with the challenge of creating a circuit for monitoring and analyzing protocol-defined information packets on an interconnect turn to the references cited by the Examiner.

The Examiner asserts that it would be obvious for one of ordinary skill in the art at the time of the Applicant’s invention to modify the invention of Wolff with the teachings of Cepuilis, Ardini, Pizzica, Bershteyn, or Merrill. Simply put, the question with respect to motivation and suggestion is whether within Wolff and/or the various pieces of art cited by the Examiner, is there motivation to combine elements of the invention as done by the Applicant to create the claimed interconnect. To that inquiry the answer is “no”.

The Court in *Rouffet* stated that to “prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.” *Rouffet* at 1350. The Examiner in *Rouffet* relied on the high level of skill in the art to provide the necessary motivation. Finding such motivation absent, the *Rouffet* Court stated that “if such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance.” *Id.* The Examiner here appears to be improperly invoking such a rote source of motivation and uses the Applicant’s invention as a blueprint by which to craft his rejection.

The Federal Circuit has repeatedly warned against the use of the Applicant’s invention as a blueprint by which to build a case of obviousness. The Examiner offers no explanation of the specific understanding or principle within


the knowledge of one skilled in the art that would motivate one with no knowledge of the Applicant's invention to combine cited the teachings.

In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicant's attorney at the telephone number listed below.

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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